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EXAMINER

SMITH, PETER J

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/552,262	Applicant(s) DUNIETZ ET AL	
	Examiner Peter J. Smith	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed on 9/29/2005.
2. Claims 1-35 are pending in the case. Claims 1, 10, 12, 14, 16, 19, 24, and 32 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 2, 5, 7, 9, and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada et al. (hereinafter "Tada"), US 5,745,745 patented 4/28/1998 in view of Fontaine et al. (hereinafter "Fontaine"), US 5,228,121 patented 7/13/1993.

Regarding independent claim 1 and dependent claim 9, Tada teaches identifying tags in a document having markup language content in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches replacing the tag with an alias in col. 22 lines 6-20. Tada teaches in col. 22 line 24 – col. 23 line 24 inserting a control code, which is a flag, to form an encoded structure indicating whether the information contained within the tags should be searched or not. Tada teaches in col. 6 lines 30 – col. 7 line 20 that these enhancements enable more efficient searching by excluding unnecessary sections of the text. Tada teaches an implementation on a computer readable medium in fig. 1 and col. 11 line 39 – col. 12 line 5. While Tada teaches a relation maintained between the alias and the flag, Tada does not teach combining the alias and the flag and separating the combination from the content with a separation variable. Fontaine does teach combining two or more tags or information objects into a single nested structure in col. 4 line 31 – col. 5 line 44 and col. 5 line. Since, the nested structures of Fontaine logically define the order of a document and the informational objects contained within the document, the boundaries of the combined structure encapsulating the alias and flag of Tada would have been separation variables separating the encode tag structure from the content.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Tada and Fontaine to have created the claimed invention. It would have been obvious and desirable to have combined the alias and flag of Tada into a single structure in the form of a document object as taught by Fontaine so that the information would have retained a document format as is taught by Fontaine as opposed to the database format explicitly taught by Tada. Thus, by retaining a document format, the content could be manipulated and used as a document.

Regarding dependent claim 2, Tada teaches identifying tags in a document having markup language content in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches replacing at least one attribute type within the tag with an attribute alias, wherein the attribute alias is a predefined representation for the attribute type in col. 22 lines 6-20.

Regarding dependent claim 5, Tada teaches inserting a position flag to indicate whether the tag is a start tag or an end tag in col. 22 lines 6-20.

Regarding dependent claim 7, Tada teaches inserting a no search flag in association with a portion of the content information, whereby a no search field may be readily identified and skipped during a run-time linear search in col. 22 line 24 – col. 23 line 24.

Regarding independent claim 16 and dependent claim 18, Tada teaches identifying tags in a document having markup language content in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches replacing the tag with an alias whereby the tag may be readily identified during run-time parsing of the document in col. 22 lines 6-20. Tada teaches an implementation on a computer readable medium in fig. 1 and col. 11 line 39 – col. 12 line 5. Tada does not teach separating the alias from the content with a separation variable. Fontaine teaches combining tags and information objects into a single nested structure in col. 4 line 31 – col. 5 line 44 and col. 5 line. Since, the nested structures of Fontaine logically define the order of a document and the informational objects contained within the document, the boundaries of the structure encapsulating the alias of Tada would have been separation variables separating the encode tag structure from the content.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Tada and Fontaine to have created the

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claimed invention. It would have been obvious and desirable to have defined the alias of Tada as a single structure in the form of a document object as taught by Fontaine so that the information would have retained a document format as is taught by Fontaine as opposed to the database format explicitly taught by Tada. Thus, by retaining a document format, the content could be manipulated and used as a document.

Regarding dependent claim 17, Tada teaches identifying tags in a document having markup language content in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches replacing at least one attribute type within the tag with an attribute alias, wherein the attribute alias is a predefined representation for the attribute type in col. 22 lines 6-20.

Regarding independent claim 19, Tada teaches a tag having encoded therein a predefined integer alias for the tag in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches replacing the tag with the alias in col. 22 lines 6-20. Tada teaches a content portion associated with the tag in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches an implementation on a computer readable medium in fig. 1 and col. 11 line 39 – col. 12 line 5. Tada does not teach a code separating the tag from the content portion. Fontaine teaches combining tags and information objects into a single nested structure in col. 4 line 31 – col. 5 line 44 and col. 5 line. Since, the nested structures of Fontaine logically define the order of a document and the informational objects contained within the document, the boundaries of the structure encapsulating the alias of Tada would have been a code separating the tag from the content.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Tada and Fontaine to have created the

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claimed invention. It would have been obvious and desirable to have defined the alias of Tada as a single structure in the form of a document object as taught by Fontaine so that the information would have retained a document format as is taught by Fontaine as opposed to the database format explicitly taught by Tada. Thus, by retaining a document format, the content could be manipulated and used as a document.

Regarding dependent claim 20, Tada teaches wherein the tag further includes at least one flag wherein the flag is selected from the group consisting of WORDBREAK, NOSEARCH, STARTTAG, and ENDTAG in col. 22 line 24 – col. 23 line 24.

Regarding dependent claim 21, Tada teaches identifying tags in a document having markup language content in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches wherein the tag further includes at least one pre-defined attribute type alias in col. 22 lines 6-20.

5. Claims 3, 4, 8, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada et al. (hereinafter “Tada”), US 5,745,745 patented 4/28/1998 in view of Fontaine et al. (hereinafter “Fontaine”), US 5,228,121 patented 7/13/1993 as applied to claims above, and further in view of “Open eBook Publication Structure 1.0” published 9/16/1999 (hereinafter “Open eBook”).

Regarding dependent claim 3, Tada does not teach UTF-8 encoding the first encoded document to form a second encoded document. Open eBook does teach UTF-8 encoding the first encoded document to form a second encoded document in section 1.4.6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined

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the teachings Open eBook, Tada, and Fontaine to have created the claimed invention. It would have been obvious and desirable to have used UTF-8 encoding taught by Open eBook to have created a second document so that it only uses half of the space a UTF-16 document would require. This would have been desirable and beneficial for using less storage space and taking less time to transmit the file.

Regarding dependent claim 4, Tada teaches compressing an encoded document to form a compressed document in col. 6 lines 4-29.

Regarding dependent claim 8, Tada teaches replacing a tag with a reference string alias in col. 22 lines 6-20. Tada does not teach replacing a URL within content information with a reference string, whereby the file referenced by the URL may be readily accessed when selected during run-time. Open eBook is partially based on HTML 4.0 as taught in sections 1.4.3 and 3. Thus, Open eBook teaches replacing a URL with a reference string, whereby the file referenced by the URL may be readily accessed when selected during run-time. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Tada, Fontaine, and Open eBook to have created the claimed invention. It would have been obvious and desirable to implemented the Open eBook teaching of replacing a URL with a reference string so that the user could have selected a descriptive reference string instead of a non-descriptive URL at run-time.

Regarding dependent claim 22, Tada does not teach wherein the markup language document is UTF-8 encoded. Open eBook does teach wherein a markup language document is UTF-8 encoded in section 1.4.6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings Open eBook, Tada, and

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Fontaine to have created the claimed invention. It would have been obvious and desirable to have used UTF-8 encoding taught by Open eBook to have encoded the markup language document so that it only uses half of the space a UTF-16 document would require. This would have been desirable and beneficial for using less storage space and taking less time to transmit the file.

Regarding dependent claim 23, Tada teaches compressing an encoded document to form a compressed document in col. 6 lines 4-29.

6. **Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tada et al. (hereinafter "Tada"), US 5,745,745 patented 4/28/1998 in view of Fontaine et al. (hereinafter "Fontaine"), US 5,228,121 patented 7/13/1993 as applied to claim 1 above, and further in view of Carus et al. (hereinafter "Carus"), US 6,035,268 provisional filed 8/22/1996.**

Regarding dependent claim 6, Tada teaches identifying tags in a document having markup language content in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches replacing the tag with an alias in col. 22 lines 6-20. Tada teaches in col. 22 line 24 – col. 23 line 24 inserting a control code, which is a flag, to form an encoded structure indicating whether the information contained within the tags should be searched or not. Tada teaches in col. 6 lines 30 – col. 7 line 20 that these enhancements enable more efficient searching by excluding unnecessary sections of the text. Thus, Tada teaches pre-computing a text to improve run-time search operation as is further described in col. 6 lines 30 – col. 7 line 20. Tada teaches an implementation on a computer readable medium in fig. 1 and col. 11 line 39 – col. 12 line 5.

Tada does not teach comparing a left and right term to determine if they are part of a single word and if they left and right terms are not part of a single word, inserting a word break flag between the left and right terms. Carus does teach comparing a left and right term to determine if they are part of a single word and if they left and right terms are not part of a single word, inserting a word break flag between the left and right terms in col. 2 line 62 – col. 3 line 31 and col. 5 lines 51-67. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Tada, Fontaine, and Carus to have created the claimed invention. Carus notes that identifying the word breaks is a computationally expensive process in col. 2 lines 46-61. Thus, it would have been obvious and desirable to have implemented the word break identification of Carus in the text search improvement pre-processing so that the computationally expensive step of identifying word breaks would have been performed prior to the run-time search. Since Tada is also trying to pre-process text to improve run-time performance by reducing the run-time computational burden, this combination would have been very desirable to one of ordinary skill in the art at the time of the invention.

7. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada et al. (hereinafter “Tada”), US 5,745,745 patented 4/28/1998 in view of Carus et al. (hereinafter “Carus”), US 6,035,268 provisional filed 8/22/1996.

Regarding independent claim 10 and dependent claim 11, Tada teaches identifying tags in a document having markup language content in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches replacing the tag with an alias in col. 22 lines 6-20. Tada

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teaches in col. 22 line 24 – col. 23 line 24 inserting a control code, which is a flag, to form an encoded structure indicating whether the information contained within the tags should be searched or not. Tada teaches in col. 6 lines 30 – col. 7 line 20 that these enhancements enable more efficient searching by excluding unnecessary sections of the text. Thus, Tada teaches pre-computing a text to improve run-time search operation as is further described in col. 6 lines 30 – col. 7 line 20. Tada teaches an implementation on a computer readable medium in fig. 1 and col. 11 line 39 – col. 12 line 5.

Tada does not teach comparing a left and right term to determine if they are part of a single word and if they left and right terms are not part of a single word, inserting a word break flag between the left and right terms. Carus does teach comparing a left and right term to determine if they are part of a single word and if they left and right terms are not part of a single word, inserting a word break flag between the left and right terms in col. 2 line 62 – col. 3 line 31 and col. 5 lines 51-67. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Tada and Carus to have created the claimed invention. Carus notes that identifying the word breaks is a computationally expensive process in col. 2 lines 46-61. Thus, it would have been obvious and desirable to have implemented the word break identification of Carus in the text search improvement pre-processing so that the computationally expensive step of identifying word breaks would have been performed prior to the run-time search. Since Tada is also trying to pre-process text to improve run-time performance by reducing the run-time computational burden, this combination would have been very desirable to one of ordinary skill in the art at the time of the invention.

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8. Claims 12 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Tada et al. (hereinafter “Tada”), US 5,745,745 patented 4/28/1998.

Regarding independent claim 12 and dependent claim 13, Tada teaches identifying a tag within a document associated with a portion of content in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches in col. 22 line 24 – col. 23 line 24 inserting a control code, which is a flag, to form an encoded structure indicating whether the information contained within the tags should be searched or not. Tada teaches in col. 6 lines 30 – col. 7 line 20 that these enhancements enable more efficient searching by excluding unnecessary sections of the text. Thus, Tada teaches pre-computing the text to improve run-time search operations. Tada teaches an implementation on a computer readable medium in fig. 1 and col. 11 line 39 – col. 12 line 5.

Tada does not teach that the no search flag is conditionally inserted based on determining whether the portion is to be displayed for viewing by a reading device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Tada to have created the claimed invention. It would have been obvious and desirable to have used the search exclusion technique of Tada to have excluded portions which are not to be displayed by a viewing device from searching. This would have corresponded to the goal of Tada of improving run-time search operations as described in col. 6 lines 30 – col. 7 line 20.

9. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Open eBook Publication Structure 1.0” (hereinafter “Open eBook”) published 9/16/1999.

Regarding independent claim 14 and dependent claim 15, Open eBook teaches a document structure partially based on XML, HTML, and other document technologies in section 1.4 pages 3-7. Thus, Open eBook teaches using and identifying Uniform Resource Locators (URL) within a document. Open eBook teaches in section 2.3 on page 18 a manifest file which contains both a URL and an associated reference string. Open eBook describes a computer readable medium implementation in the reading device definition in section 1.3 on page 2. Open eBook does not specifically teach replacing part of a URL identified in the document with the reference string and a flag for the file. However replacing a URL with a reference string is described was known by the linking technology of HTML at the time of the invention on which Open eBook is partially based. This allowed a the string to be displayed and the actual details of the URL hidden from display, but appended to the string. When the string was selected by a user, the URL was activated. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Open eBook to have created the claimed invention. It would have been obvious and desirable to have modified Open eBook to have replaced URLs in the document with the associated reference string so that the link would have been more descriptive to the user.

10. Claims 24-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Open eBook Publication Structure 1.0” published 9/16/1999 (hereinafter “Open eBook”) in view of Tada et al. (hereinafter “Tada”), US 5,745,745 patented 4/28/1998.

Regarding independent claim 24, Open eBook teaches a root directory in sections 2 and 2.1 on pages 11 and 12. The package element is the outermost element in a package file and all

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other elements are nested within it, thus it is the root directory. Open eBook teaches a content subdirectory linked to the root directory, the content subdirectory having nested therein at least one linked content file providing content information relating to the electronic book in sections 2 and 2.1 on pages 11 and 12. The package element is the outermost element in a package file and all the other elements are nested within it, thus the other elements are contained in a subdirectory linked to the root directory. The subdirectory is described by the manifest, which Open eBook describes in section 2.3.

Open eBook does not teach wherein the content file is pre-computed and encoded to minimize run-time requirements. Tada does teach a content file which is pre-computed and encoded to minimize run-time requirements in col. 1 lines 7-13, col. 21 lines 50-64, col. 22 lines 6-20, and col. 22 line 24 – col. 23 line 24. Tada teaches in col. 6 lines 30 – col. 7 line 20 the advantage of decreased search time as a result of pre-computing and encoding the content file. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Open eBook and Tada to have created the claimed invention. It would have been obvious and desirable to have used the content file pre-computing and encoding as taught by Tada to have enabled fast run-time search operations on a the Open eBook, which is often implemented on a low power portable reading device.

Regarding dependent claim 25, Open eBook teaches at least one link destination index file linked to the content file in section 2.3 page 18.

Regarding dependent claim 26, Open eBook teaches a page break index providing an index of page break corresponding to the electronic book in sections 2.3, 2.4 and 2.6 pages 18, 19, and 21.

Regarding dependent claim 27, Open eBook teaches a metadata file linked to the root directory and having information about the electronic book in sections 2.2 pages 12-17.

Regarding dependent claim 28, Open eBook teaches a manifest file linked to the root directory providing a listing of the files in the content subdirectory relating to the electronic book in section 2.3 page 18.

Regarding dependent claim 29, Open eBook teaches using at least one Cascading Style Sheet (CSS) file in section 4 pages 39-47.

Regarding dependent claim 30, Open eBook teaches a metadata file linked to the root directory and having information about the electronic book in sections 2.2 pages 12-17.

Regarding dependent claim 31, Open eBook teaches a digital rights management database linked to the root database in sections 2 and 2.1 pages 11 and 12.

Regarding independent claim 32 and dependent claim 35, Open eBook teaches a root directory in sections 2 and 2.1 on pages 11 and 12. The package element is the outermost element in a package file and all other elements are nested within it, thus it is the root directory. Open eBook teaches a content subdirectory linked to the root directory, the content subdirectory having nested therein at least one linked content file providing content information relating to the electronic book in sections 2 and 2.1 on pages 11 and 12. The package element is the outermost element in a package file and all the other elements are nested within it, thus the other elements are contained in a subdirectory linked to the root directory. The subdirectory is described by the manifest, which Open eBook describes in section 2.3.

Open eBook does not teach converting a document in a first format by processing the document to pre-compute and encode the markup language within the document. Tada does

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teach converting a document in a first format by processing the document to pre-compute and encode the markup language within the document in col. 1 lines 7-13, col. 21 lines 50-64, col. 22 lines 6-20, and col. 22 line 24 – col. 23 line 24. Tada teaches an implementation on a computer readable medium in fig. 1 and col. 11 line 39 – col. 12 line 5. Tada teaches in col. 6 lines 30 – col. 7 line 20 the advantage of decreased search time as a result of pre-computing and encoding the document into a converted document. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Open eBook and Tada to have created the claimed invention. It would have been obvious and desirable to have used the document pre-computing and encoding as taught by Tada to have enabled fast run-time search operations on a the Open eBook, which is often implemented on a low power portable reading device.

Regarding dependent claim 33, Open eBook teaches wherein the first format is an Open E-Book format in section 2 pages 11-21.

Regarding dependent claim 34, Open eBook teaches wherein the document is an electronic book in section 2 pages 11-21.

Response to Arguments

11. Applicant's arguments filed 9/29/2005 have been fully considered but they are not persuasive. Regarding Applicant's arguments in pages 7-9 that Tada and Fontaine to not teach all the limitations of independent claim 1, the Examiner respectfully disagrees. The Examiner believes Fontaine does in fact teach the separation variable within the broadest reasonable interpretation of the term as claimed. Fontaine teaches and example tag named "tagname" in col.

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4 line 59. Since this tag cannot be distinguished from the text content, a separation variable is plainly shown also in col. 4 line 59. In the example of Fontaine, the variable %% is used to separate the tag from the text content. The separation variable enables Fontaine to identify the tag and invoke its definition which is described in col. 4 lines 49-55. Therefore, the Examiner maintains the position that Fontaine does teach the claimed separating a tag from content with a separation variable. The Examiner maintains the belief that Tada teaches the claimed replacing a tag with an alias, wherein the alias is a pre-defined representation for the tag. The Examiner's citation of col. 22 lines 6-20 teaches obtaining an identification number, or alias, corresponding to a tag. Tada further describes in col. 22 line 24 – col. 23 line 25 that the tag is replaced by a combination of the control code and the identification number to improve the searching of the text content. Therefore, the Examiner maintains that Tada does teach the claimed replacing a tag with an alias, wherein the alias is a pre-defined representation for the tag. The Examiner maintains that Tada teaches the creation of an encode tag structure. Tada teaches in col. 22 line 24 – col. 23 line 25 that the control code and the identification number are used to replace the tag so that the searching of the text content is improved. The control code and identification paired together for a structure as is claimed. The purpose of the structure is to improve the search of the text content. Regarding Applicant's assertion of impermissible hindsight regarding independent claim 1, the Examiner respectfully disagrees. As shown above, Tada clearly teaches a tag alias, and a tag related flag. Tada uses the created structure to improve the search of text content, as is a similar goal of the invention of claim 1. Fontaine teaches an improvement for separating a take from text content. The improvement of Fontaine would have enabled the tag search improvement of Tada to have been implemented in the document. Fontaine teaches placing and

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separating the tags within the text content directly in col. 4 lines 57-63. Thus, the Examiner believes this improvement to have been created by one of ordinary skill in the art at the time of the invention by expressly using the stated advantages of Tada and Fontaine. It is for at least these reasons the Examiner maintains the rejection of claims 1, 2, 5, 7, and 9 as being unpatentable over Tada in view of Fontaine.

Regarding Applicant's arguments in pages 10 and 11 that Tada and Fontaine do not teach all of the limitations of independent claim 16, the Examiner respectfully disagrees. The Examiner believes Fontaine does in fact teach the separation variable within the broadest reasonable interpretation of the term as claimed. Fontaine teaches an example tag named "tagname" in col. 4 line 59. Since this tag cannot be distinguished from the text content, a separation variable is plainly shown also in col. 4 line 59. In the example of Fontaine, the variable %% is used to separate the tag from the text content. The separation variable enables Fontaine to identify the tag and invoke its definition which is described in col. 4 lines 49-55. Therefore, the Examiner maintains the position that Fontaine does teach the claimed separating a tag from content with a separation variable. The Examiner maintains the belief that Tada teaches the claimed replacing a tag with an alias, whereby the tag may be readily identified during run-time parsing of the document. The Examiner's citation of col. 22 lines 6-20 teaches obtaining an identification number, or alias, corresponding to a tag. Tada further describes in col. 22 line 24 – col. 23 line 25 that the tag is replaced by a combination of the control code and the identification number to improve the searching of the text content. Therefore, the Examiner maintains that Tada does teach the claimed replacing a tag with an alias, whereby the tag may be readily

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identified during run-time parsing of the document. It is for at least these reasons the Examiner maintains the rejection of claims 16-18 as being unpatentable over Tada in view of Fontaine.

Regarding Applicant's arguments in pages 11 and 12 that Tada and Fontaine do not teach all of the limitations of independent claim 19, the Examiner respectfully disagrees. The Examiner maintains the belief that Tada teaches the claimed replacing a tag with an alias, wherein the alias is a pre-defined representation for the tag. The Examiner's citation of col. 22 lines 6-20 teaches obtaining an identification number, or alias, corresponding to a tag. Tada further describes in col. 22 line 24 – col. 23 line 25 that the tag is replaced by a combination of the control code and the identification number to improve the searching of the text content. Therefore, the Examiner maintains that Tada does teach the claimed replacing a tag with an alias, wherein the alias is a pre-defined representation for the tag. The Examiner believes Fontaine does in fact teach the separation variable within the broadest reasonable interpretation of the term as claimed. Fontaine teaches an example tag named "tagname" in col. 4 line 59. Since this tag cannot be distinguished from the text content, a separation variable is plainly shown also in col. 4 line 59. In the example of Fontaine, the variable %% is used to separate the tag from the text content. The separation variable enables Fontaine to identify the tag and invoke its definition which is described in col. 4 lines 49-55. Therefore, the Examiner maintains the position that Fontaine does teach the claimed separating a tag from content with a separation variable. It is for at least these reasons the Examiner maintains the rejection of claims 19-23 as being unpatentable over Tada in view of Fontaine.

Regarding Applicant's arguments in pages 12 and 13 that Tada and Carus do not teach all of the limitations of claims 10 and 11, the Examiner respectfully disagrees. Carus teaches

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identifying a position and determining whether it is between words or within a word in col. 5 lines 51-67. Therefore, it provides the teaching of determining whether a tag is within a single word. The Examiner also disagrees with the Applicant's assertion that Tada and Carus are combined using impermissible hindsight. Both Tada and Carus teach pre-computing text content to improve run-time operations such as search. Therefore, the Examiner believes the teachings and advantages of both references would have been known to one of ordinary skill in the art at the time of the invention. One of ordinary skill in the art at the time of the invention would have been motivated to have improved Tada with the teaching of Carus to have performed the computationally expensive processing prior to the searching as is taught by Carus in col. 2 lines 46-61. It is for at least these reasons the Examiner maintains the rejection of claims 10 and 11 as being unpatentable over Tada in view of Carus.

Regarding Applicant's arguments in pages 13 and 14 that Tada does not teach or suggest all of the limitations of claims 12 and 13, the Examiner respectfully disagrees. Tada teaches in col. 22 line 24 – col. 23 line 24 inserting a control code, which is a flag, to form an encoded structure indicating whether the information contained within the tags should be searched or not. Tada teaches in col. 6 lines 30 – col. 7 line 20 that these enhancements enable more efficient searching by excluding unnecessary sections of the text. Thus, the identification number and control code combined structure read upon the broadest reasonable interpretation of the claimed no search flag. It is for at least these reasons the Examiner maintains the rejection of claims 12 and 13 as being unpatentable over Tada.

Regarding Applicant's arguments in pages 14 and 15 that Open eBook does not teach or suggest all of the limitations of claims 14 and 15, the Examiner respectfully disagrees. The

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Examiner notes Open eBook teaches a document structure partially based on XML, HTML, and other document technologies in section 1.4 pages 3-7. Thus, Open eBook teaches using and identifying Uniform Resource Locators (URL) within a document. One of ordinary skill in the art at the time of the invention would have modified Open eBook to have employed replacing a URL with a reference string as was known by the linking technology of HTML. The one of ordinary skill in the art at the time of the invention would have been motivated to make this modification so that the link would have been more descriptive to the user. It is for at least these reasons the Examiner maintains the rejection of claims 14 and 15 as being unpatentable over Open eBook.

Regarding Applicant's arguments in pages 15 and 16 that Open eBook and Tada do not teach or suggest all the limitations of claims 24-31, the Examiner respectfully disagrees. The Examiner disagrees with Applicant's assertion of impermissible hindsight regarding these claims. Open eBook teaches an electronic document format partially based on XML, HTML, and other document technologies. Tada teaches pre-computing a document to improve its run-time search capabilities. The Examiner believes it would have been obvious to one of ordinary skill in the art at the time of the invention to have improved the Open eBook document using the pre-computing search optimizations taught by Tada. Thus, the motivation to combine the references is derived from Tada and not Applicant's invention. It is for at least these reasons the Examiner maintains the rejection of claims 24-31 as being unpatentable over Open eBook in view of Tada.

Regarding Applicant's arguments in pages 16 and 17 that Open eBook and Tada do not teach or suggest all the limitations of claims 32-35, the Examiner respectfully disagrees. The

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Examiner disagrees with Applicant's assertion of impermissible hindsight regarding these claims. Open eBook teaches an electronic document format partially based on XML, HTML, and other document technologies. Tada teaches pre-computing a document to improve its run-time search capabilities. The Examiner believes it would have been obvious to one of ordinary skill in the art at the time of the invention to have improved the Open eBook document using the pre-computing search optimizations taught by Tada. Thus, the motivation to combine the references is derived from Tada and not Applicant's invention. It is for at least these reasons the Examiner maintains the rejection of claims 24-31 as being unpatentable over Open eBook in view of Tada.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Smith whose telephone number is 571-272-4101. The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PJS
12/19/2005

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
12/19/2005